



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Peter F. Titus

Filed: July 1, 2003

Serial No.: 10/611,705

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Group Art Unit: 3712

Examiner: Fernstrom, Kurt

Attorney Docket: PT 03153

Date: April 29, 2005

For: WORD KEY

MAIL STOP APPEAL BRIEF-PATENTS
COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

Enclosed, herewith, is an Appeal Brief (in triplicate) in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37).

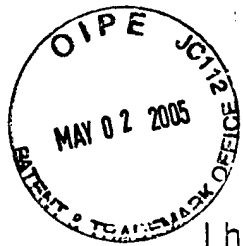
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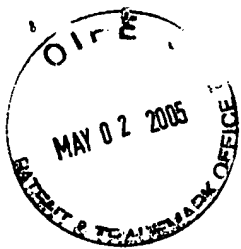
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

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COMMISSIONER OF PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

Sir:

The following appeal brief for Appellant under Rule 1.192 is submitted pursuant to the Notice of Appeal filed November 11, 2004 in the above-identified application. Further, this appeal brief is submitted pursuant to a Notification of Non-Compliant Appeal Brief mailed March 31, 2005.

(1) Real Party in Interest

The real party in interest of the present application is Peter F. Titus.

(2) Related Appeals and Interferences

There are no appeals or interferences pending which directly affect this application.

(3) Status of Claims

Claims 1-20 are currently pending in the application. Claims 1-20 stand rejected and all of claims 1-20 are being appealed.

(4) Status of Application

The amendment filed subsequent to the final rejection requested a reconsideration of the rejection. The Examiner stated that the "request for reconsideration has been considered but does not place the application in condition for allowance because: of the reasons set forth in the Response to the Arguments section of the Final Rejection."

(5) Summary of Invention

The present invention provides an apparatus (10) for marking a page in a predetermined book. The apparatus comprises a substrate (2) having a predetermined size and a predetermined configuration and selected words (4) disposed adjacent definitions (6) of the selected words (4) on at least one side of the substrate (2), the selected words (4) being words that are used in such predetermined book which would likely require a reader of such book to go to a dictionary to find a meaning for such words (4). (Page 4, line 4 to page 5, line 2).

The invention also provides an apparatus (10) wherein the definitions (6) of the words (4) includes appropriate synonyms. (Page 4, lines 12-16).

Additionally the invention provides an apparatus (10) wherein the predetermined configuration is generally rectangular. (Page 6, lines 24-26).

Further provided by the invention is an apparatus (10) wherein the predetermined size is substantially about 43 by 82 inches. (Page 6, line 25 to page 7, line 3).

In addition the invention provides an apparatus (10) wherein the selected words (4) are printed in bold print. (Page 5, lines 16-19).

Also the invention provides an apparatus (10) wherein the definitions (6) of the selected words (4) are printed in standard print. (Page 5, lines 16-19).

Further, the invention provides an apparatus wherein the selected words (4) are arranged in an alphabetical order. (Page 5, lines 8-10).

Additionally, the invention provides an apparatus (10). wherein the apparatus (10) further includes a magnifying slide affixed to the substrate (2). (Page 8, lines 11-15).

(6) Grounds of Rejection

The first ground of rejection by the Examiner was the rejection of claims 1-3, 7-9, 11, 13 and 14 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360. The Examiner contends that "...Goodman discloses in Figures 1 and 4 and in column 3, line 35 to column 4, line 25 an apparatus comprising a rectangular substrate 26 having a predetermined size and configuration, wherein information pertaining to a particular book is printed on the substrate. While Goodman does not explicitly disclose that definitions of words are provided on the substrate, Goodman does disclose that various types of information, including descriptions of characters and answers to questions, are provided. Words and definitions are very analogous to characters and their descriptions, and would have been an obvious variation to one of ordinary skill in the art for the purpose of providing a reference guide to selected words. The phrase `for marking a page in a predetermined book= is functional language, which describes the intended purpose of the device

rather than providing further structural limitation, and thus is not deemed to have patentable weight. The substrate of Goodman is physically capable of being used to mark a book. With respect to claims 2 and 3, while the material used to form the substrate is not explicitly disclosed,

Official Notice is taken that it is well known to use paper for sheets such as that of the Goodman device. With respect to claim 7, Official Notice is taken that in providing definitions of words, it is well known too utilize synonyms. Such a feature would have been obvious for the purpose of enabling a user to easily and quickly determine the definition of a word. With respect to claim 9, while the size of the sheet is not explicitly disclosed, Official Notice is taken that reference sheets are provided in many different sizes. The specific size claimed would have been an obvious variation. With respect to claim 11, Official Notice is taken that standard print is, well, standard for sheets containing printed matter. With respect to claim 13, the word key logo does not appear to have a specific function apart from trademarking or decorative purposes, and as such is an aesthetic choice of design. With respect to claim 14, Goodman discloses in Figure 4 that the Title of the book is provided on the substrate. Modification to include the author's name would

have been obvious for the purpose of providing additional detail regarding the book."

The second ground of rejection by the Examiner was the rejection of claims 4,5 and 16-20 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Renegar, U.S. Patent No. 6,024,571. The Examiner contends that "Goodman discloses all of the limitations of claims 4 and 5 with the exception of the lamination. Providing lamination to printed matter including reference lists is well known, as disclosed for example in column 6, lines 15-18 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. With respect to claim 5, it is well known, when laminating an article, to use plastic. Goodman further discloses or suggests all of the limitations of claims 16-20 with the exception of the folding creases. Providing folding creases to printed matter including reference lists is well known, as disclosed for example in Figures 4-9 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by I providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. At least 8 surfaces are

shown in Figure 6 (the four shown, and the four on the rear side.)"

The third ground of rejection by the Examiner was the rejection of claim 6 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Renegar, U.S. Patent No. 6,024,571 and further in view of Finkelstein et al., U.S. Patent No. 5,856,661. The Examiner contends that "Goodman as viewed in combination with Renegar discloses all of the limitations of the claim with the exception of the magnifying feature. Finkleston discloses in column 5, lines 10-59 a laminated article comprising an integral magnifying lens. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman as viewed in combination with Renegar by providing a magnifying feature for the purpose making the substrate easier to read."

The fourth ground of rejection by the Examiner was the rejection of claim 10 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Batjuk, U.S. Patent No. 5,934,708. The Examiner contends that "Goodman discloses all of the limitations of the claim with the exception of the bold print. Batjuk discloses in the Figure an apparatus

comprising a substrate having words and definitions, where the words are printed in boldface, and the definitions are provided in standard print. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing boldfaced words for the purpose of making them easier to distinguish from the definitions."

The fifth ground of rejection by the Examiner was the rejection of claim 12 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Marshall, U.S. Patent No. 6,474,992. The Examiner contends that "Goodman discloses all of the limitations of the claim with the exception of the words being in alphabetical order. Marshall discloses in Figure 1 an apparatus comprising a substrate for use with a book having letters and sounds, where the letters are provided in alphabetical order. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing words in alphabetical order for the purpose of making them easier to find on the substrate."

The sixth and final ground of rejection by the Examiner was the rejection of claim 15 as being obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Leon, U.S.

Patent No. 5,414,946. The Examiner contends that "Goodman discloses all of the limitations of the claim with the exception of the magnifying slide. Leon discloses in Figure 1 and 6 and in column 2, lines 61-64 an apparatus comprising a substrate having printed matter thereon, further comprising a magnifying slide 22. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a magnifying slide for the purpose of making the substrate easier to read."

(7) Argument

With regard to the first ground of rejection, Goodman teaches, "According to the present invention in its broadest aspect, there is provided a reference list for use with a book, comprising a sheet having inscribed thereon information related to the contents of the book, which information is arranged in the same order as the corresponding parts of the book, and masking means overlying the information and adapted to be removed by the reader as required so as to provide a reference index in which only information relating to parts of the book already read is revealed." (Column 1, lines 45-54). (Underlining is for emphasis.)

The present invention provides a mini-dictionary in which difficult words found in the book are defined generally in the context of which the words are used in the book. There is no masking means overlying the information in the present invention as is taught by Goodman. The mini-dictionary is always available.

Further, Goodman teaches "Referring now to the drawings, there is shown in FIGS. 1 to 3 a holder of a progressive index according to a first embodiment of the invention, consisting of a three-layer structure comprising a bottom layer 2, an intermediate layer 4 and a top layer 6. The three layers are made of relatively thin, transparent plastic material such as polyethylene, P.V.C. or the like. In the embodiment as illustrated the bottom layer 2 and the top layer 6 consist of a single, folded piece of material. However, the holder can be made of three separate pieces.

In manufacturing the holder, the first step consists of thermally 'stitching' the intermediate layer 4 and the top layer 6 together by means of horizontal welding seams 8 that define the width of the thus produced pockets 10 into which fit slidingly the masking strips 12 shown ghosted-in FIG. 1 and in FIG. 3, and the vertical seam 14 which delimits the depth of the pockets 10 so that even when the strips are inserted into the pockets 10 as

far as they will go, i.e. right up to the seam 14, their free end 16 will slightly project beyond the edge 18 of the pocket 10 to facilitate manipulation.

As a final step, the bottom layer 2 is joined to the already joined intermediate and top layers 4 and 6. In the illustrated embodiment this is effected by two additional welding seams, a vertical seam 20 and a horizontal seam 22 that also delimits the lowermost pocket 10.

If the bottom layer 2 and the top layer 6 are made of separate pieces, an additional horizontal seam 22 is of course required at the top edge of the holder. The seams 20 and 22 have now defined a compartment 24 into which slidably fits a sheet 26 on which there is printed the information relevant to the book, for example the list of characters appearing in the book." (Column 3, line 35 to Column 4, line 1).

The present invention has no pockets nor are there any "weldable" or "stitched" seams as is taught by Goodman. The teaching of Goodman provides for a rather elaborate apparatus that is designed to provide answers to questions only in the order that they appear in the book. The present invention provides a substrate, which may be folded or can be used as a simple one page sheet, with words and definitions presented on at least one side of the substrate and which is available to the

reader at any time. The size of the substrate (sheet) is such that it can be used as a bookmark without being unwieldy and which also keeps the apparatus handy for use when needed.

The apparatus of Goodman provides for basically five layers of material. Three layers of plastic form the holder while there is a sheet of material inserted in the pocket and then there are masking strips which cover the sheet with information on it that are to be removed as the book is read. This is hardly a convenient bookmark.

Further, Goodman teaches that (with reference to paperback books) "It is thus possible for a progressive reference list to be produced on the inside cover or covers of such books and become an integral part of it. Since the average paperback has some forty five lines of print, excluding headings, a list of twenty to twenty five lines could readily be printed on the inside cover or covers of such a book. If more than this number is required to be listed, both the front and back covers could be used." (Column 2, lines 38-45). Thus, the teaching of Goodman is essentially teaching away from the use of such an apparatus as a bookmark.

The prior art of Goodman does not teach or even suggest an apparatus as that defined in the claims of the present invention. It is only in hindsight that the apparatus as taught by Goodman

can be compared to the apparatus that is provided in the present invention. Therefore, Applicant respectfully requests the Board to reverse the Examiner's rejections of claims 1-3, 7-9, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Goodman.

With regard to the second ground of rejection, Applicant does not understand why the Examiner feels that "it would be obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet".

The present invention provides for such substrate to be laminated paper. There is no need for lamination of the sheet in the Goodman apparatus since the apparatus as taught by Goodman is formed from a thin transparent material such as polyethylene and, thus, since the apparatus is encased in polyethylene laminating this apparatus would be a costly unnecessary step which would not provide any additional durability to the sheet since polyethylene is probably more durable than lamination.

Further, if the sheet itself, as taught by Goodman, were laminated it would be difficult to fit the laminated sheet into the pocket formed in the polyethylene holder. Again, this would be totally unnecessary since the sheet as taught by Goodman is protected by sheets of polyethylene.

Therefore, Applicant respectfully requests the Board to reverse the rejections of claims 4, 5 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar.

With regard to the third ground of rejection, Finkelston teaches "The subject invention is directed to a financial transaction card such as a credit card or the like which incorporates an integral magnifying lens. Use of the card of the subject invention automatically places a magnifying lens at the disposal of the user, whereby he may immediately verify a financial transaction at the point-of-sale without first locating a magnifying glass or taking the time and effort to put on reading glasses."

The present invention provides for such plastic laminated paper to include magnification in the plastic laminate. The magnifier of Finkelston is basically a magnifying lens placed in a credit card which the user may place over a sheet with sale information on it so as to be better able to read the numbers or the terms of an agreement. This is quite different than having magnification in place in the plastic laminate which is covering the apparatus. In the present invention the magnification is there all the time and is part of the apparatus and is not moveable but is in the laminate covering the words and

definitions so as to make them appear larger and easier to read by the user. The teaching of Finkelston would be no different than having a magnifying glass available instead of having the magnifier imbedded in a credit card.

Applicant does not believe that one providing an apparatus such as that of the present invention would consider searching credit card magnifiers as relevant art. Applicant believes this reference to be non-analogous art.

Applicant has previously discussed the teaching of Goodman in view of the teaching of Renegar and since Finkelston does not teach a magnification means similar to that of the present invention, Applicant respectfully requests the Board to reverse the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston.

With regard to the fourth ground of rejection, the present invention provides that such selected words disposed on such substrate are printed in bold print. Applicant has discussed previously that Goodman neither teaches nor even suggests an apparatus as that claimed in the present invention. The teaching of Batjuk which provides for an alphabetic foreign language in which words are printed in boldface and the definitions in

standard print does not affect the fact that the present invention is different from that as taught by Goodman; therefore, Applicant respectfully requests the Board to reverse the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk.

With regard to the fifth ground of rejection, The present invention provides that selected words disposed on such substrate are arranged in an alphabetical order. Marshall discloses in Figure 1 and Figure 2B words that are not in alphabetical order. The items in Figure 2A, which the Examiner referred to as Figure 1, are the common vowels and they are normally put in the order of a,e,i,o and u. However, Marshall also lists the word consonants further down on the sheet after he had listed the word(s) short vowels and since the letter c is alphabetically earlier in the alphabet than s, this is hardly an alphabetical listing. This does indicate that Marshall is not necessarily teaching words being placed in alphabetical order. Marshall is teaching sounds or word pronunciations and not definitions. Further, Goodman teaches information bearing lines that are masked initially and are progressively unmasked as the book is read. It would not be feasible for items in an alphabetical order to be masked and unmasked as the book is read. As stated

previously the present invention provides difficult words with their definitions that are always in view of the reader since the words may occur anywhere in the book.


Since it was previously discussed that Goodman does not teach the present invention and the addition of Marshall does not alter the difference between Goodman and the present invention,

Applicant respectfully requests the Board to reverse the rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall.

With regard to the sixth ground of rejection, the present invention provides a magnifying slide affixed to the substrate. The substrate is where the words and definitions of the present invention are displayed. In the invention of Goodman the information is disposed on a sheet which is encased in a pocket formed between two layers of polyethylene. It would be difficult to provide a magnifier which could slide over the sheet with information as taught by Goodman when the sheet is in a pocket and which further is covered by masking strips which are uncovered individually. Therefore, Applicant respectfully requests the Board to reverse the rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Leon.

Applicant makes note that it required 6 different prior art references for the Examiner to reject the claims of the present invention which would indicate that the invention is not really obvious with regard to the referenced prior art.

Respectfully submitted,

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8) APPENDIX

The claims on appeal are as follows:

1. An apparatus for marking a page in a predetermined book, said apparatus comprising;

(a) a substrate having a predetermined size and a predetermined configuration; and

(b) selected words disposed adjacent definitions of said selected words on at least one side of said substrate, said selected words being words that are used in such predetermined book which would likely require a reader of such book to go to a dictionary to find a meaning for such words.

2. An apparatus, according to claim 1, wherein said substrate is made of one of plastic, cardboard, paper and various combinations thereof.

3. An apparatus, according to claim 2, wherein said substrate is paper.

4. An apparatus, according to claim 3, wherein said paper is laminated paper.

5. An apparatus, according to claim 3, wherein said paper is laminated in plastic.

6. An apparatus, according to claim 5, wherein said plastic laminated paper is further modified to include magnification in said plastic laminate.

7. An apparatus, according to claim 1, wherein said definitions of said words includes appropriate synonyms.

8. An apparatus, according to claim 1, wherein said predetermined configuration is generally rectangular.

9. An apparatus, according to claim 1, wherein said predetermined size is substantially about 43 by 82 inches.

10. An apparatus, according to claim 1, wherein said selected words are printed in bold print.

11. An apparatus, according to claim 1, wherein said definitions of said selected words are printed in standard print.

12. An apparatus, according to claim 1, wherein said selected words are arranged in an alphabetical order.

13. An apparatus, according to claim 1, wherein said apparatus further includes a word key logo disposed on a first side of said at least one side of said substrate.

14. An apparatus, according to claim 13, wherein said apparatus further includes a title and an author of such predetermined book disposed beneath said word key logo.

15. An apparatus, according to claim 1, wherein said apparatus further includes a magnifying slide affixed to said substrate.

16. An apparatus, according to claim 1, wherein said apparatus further includes at least one crease to enable said substrate to be folded at least once so as to provide a plurality of surfaces.

17. An apparatus, according to claim 16, wherein said plurality of surfaces is four.

18. An apparatus, according to claim 16, wherein said plurality of surfaces is six.

19. An apparatus, according to claim 16, wherein said plurality of surfaces is eight.

20. An apparatus, according to claim 16, wherein said substrate after being folded at least once is substantially about 43 by 82 inches.